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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,254	06/15/2001	Hugh Boyd Morrison	RCA 89185	6997

7590 08/23/2005

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EXAMINER

NALEVANKO, CHRISTOPHER R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/868,254	<b>Applicant(s)</b> MORRISON ET AL.	
	<b>Examiner</b> Christopher R. Nalevanko	<b>Art Unit</b> 2611	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/13/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 07/27/2005 have been fully considered but they are not persuasive.

Regarding Claim 1, Applicant argues that “although Alexander, at col. 13, lines 36-45, states that an E-mail service (which may be interpreted as the computer application software program) can be provided, it does not disclose or suggest the features of receiving, while said computer application software program (the E-mail) is running, an advertisement associated with a broadcast television program', and operating said video processing apparatus in a video operating mode for obtaining the broadcast television program in response to selecting said advertisement, as recited in amended claim 1. The Office Action appears to interpret the EPG as the computer application software program. An electronic programming guide (EPG), however, is not a computer application software program as recited in amended claim 1, because the EPG program does not permit a user to send and receive electronic messages to and from another user/computer” (page 5 lines 5-16). Examiner asserts that the EPG of Alexander can be read as a “computer application software” because there is nothing in the claimed limitations that describes sending and receiving electronic messages to and from another user. Although “receiving electronic messages” is claimed, these electronic messages could be data or control messages from the head-associated with programming. There is nothing that states these messages must come from another user or that the computer software must be “email” software. It is noted that the features upon which applicant

relies (i.e., email software, sending messages between users and computers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Alexander et al (6,177,931).

Regarding Claim 1, Alexander shows a method for operating a video processing apparatus comprising operating a computer application software program on said video processing apparatus (col. 5 lines 5-52, hardware and software used for displaying EPG guide and functioning apparatus), said computer application software program capable of receiving electronic messages (col. 8 lines 20-65, downloading supplemental data, Internet data, col. 13 lines 25-35, email data being received), receiving, in while said computer application software program is running, an advertisement associated with a broadcast television program, causing said advertisement to be displayed (col. 4 lines 28-35, col. 14 lines 1-20, col. 19 lines 50-67, col. 20 lines 1-28, displaying advertisement

information about upcoming shows or products, EPG program and browsing software runnign), selecting said advertisement (col. 4 lines 28-35, selecting the program in the advertisement for viewing or recording), and operating said video processing apparatus in a video operating mode for obtaining the television program in response to said advertisement (col. 4 lines 28-35, selecting the program in the advertisement for viewing or recording).

Regarding Claim 2, Alexander shows that the system can communicate and perform productive functions (col. 5 lines 5-52, hardware and software used communicating with broadcaster and allowing user to select different functions).

Regarding Claim 3, Alexander shows that the advertisement information contains control information pertaining to time, channel, and recording functions (col. 4 lines 28-35, recording program associated with ad, lines 50-56, displaying channel and time data, col. 18 lines 1-12, access further information about programs and advertisements, col. 20 lines 12-36).

Regarding Claim 4, Alexander shows that control information comprises program data, and wherein time and channel data is determined using an electronic program guide in response to said program data (col. 5 lines 5-15, col. 7 lines 1-15, data associated with program from EPG, see fig. 1, 3-10).

Regarding Claim 5, Alexander shows that the step of operating comprising recording the program associated with the advertisement (col. 4 lines 28-35, recording program associated with ad, lines 50-56, displaying channel and time data, col. 18 lines 1-12, access further information about programs and advertisements, col. 20 lines 12-36).

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Nalevanko whose telephone number is 571-272-7299. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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